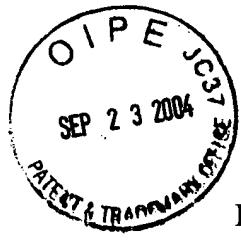


IFW



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: pending Patent Application :  
of:  
Grigsby Jr., et al. : Group Art Unit: 1711  
Serial No. 10/630,121 :  
Filing Date 07/30/03 : Examiner: COONEY; JOHN  
For: "ORGANIC ANION CATALYST SYSTEM : Docket # 81488  
FOR FOAMS" :

9/17/04

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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Martha Victory

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Restriction Requirement dated August 27, 2004, Applicants respectfully traverse the basis for restriction, and respectfully assert that restriction is neither applicable nor justified in this case, and further that examination of all claims does not constitute an undue burden on the Examiner.

The Application contains a total of 20 claims, and the Examiner has divided these claims

into two 2 Groups, based on Class and Subclass in which the claimed inventions are presumed to be classified, in accordance with the classification system of the U.S. Patent Office. The Groups are as follows:

Group	Claims	Class	Subclass
I	1-14	502	100
II	15-20	521	50

The Examiner indicates that the inventions of Groups I and II are related as mutually exclusive species in an "intermediate-final product relationship". This basis for restriction does not appear to be tenable because it appears to be based on an erroneous understanding of the cited MPEP guidelines. For example, the Examiner cites MPEP § 806.04(h), which relates to the instance where an Applicant files a divisional application claiming a species previously claimed but not elected in the parent case. In such an application, the MPEP further cautions the Examiner "should not require restriction to a reasonable number of species, unless he or she is satisfied that he or she would be prepared to allow claims to each of the claimed species over the parent case, if presented in a divisional application filed according to the requirement. Restriction should not be required if the species claims are considered clearly unpatentable over each other." In the present case, the Examiner has made no reference to the parent case (in fact, there is none) and so has not even attempted a prima facie case. Applicants therefore respectfully request that the Examiner withdraw any restriction requirement based on MPEP § 806.04(h) because the presently pending claims are not claims to "species previously claimed but

not elected" in a "parent case".

Further, the Examiner also relies on MPEP § 806.04(b), specifically the third paragraph. This third paragraph provides an example of species of carbon compounds that may be related to each other as intermediate and final products. The MPEP states that these species are not independent, and in order for the Examiner to sustain a restriction requirement, "distinctness must be shown" (by the Examiner). Thus, the MPEP makes a presumption that a restriction is inappropriate unless distinctness is shown, and the Examiner has made no effort to show distinctiveness. Merely saying they are distinct does not make it so. At least some factual reasons must be given, and a mere conclusory statement does not suffice. Accordingly, the Examiner has again failed to even make a *prima facie* case for rebuttal. [ As a further guide, the MPEP says that distinctness is proven if it can be shown that the intermediate product is useful other than to make the final product. Otherwise, the disclosed relationship would preclude their being issued in separate patents. In this case, the invention of Group I is directed to a catalyst composition useful in producing a foam product, that can be used in a variety of applications, in the same way that any other catalyst might find a multiplicity of uses, albeit that those uses might not be identical to those of the particular catalyst in question here. There is no "intermediate product" or "final product" as referred to in the MPEP § 806.04(b), and so section 806.04(b) of the MPEP is not applicable to this case. The claims of Group II specify the use of a catalyst, and aspects of that catalyst are set forth in Group I. Accordingly, we have here a relationship between a final product (catalyst composition) and uses of that final product (process for making a foam with the Group I catalyst composition), quite distinct from the example in the MPEP